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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/558,884

11/29/2005

Joerg Fuchslocher

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EXAMINER

PRANGE, SHARON M

ART UNIT

PAPER NUMBER

3728

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/558,884	<b>Applicant(s)</b> FUCHSLOCHER ET AL.	
	<b>Examiner</b> SHARON M. PRANGE	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 6-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,6-9 and 12-16 is/are rejected.
- 7) ☒ Claim(s) 10,11 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This is in response to Applicant's amendment in which claims 1 and 6-10 have been amended, claims 2, 4, and 5 have been canceled, and claims 17-36 have been withdrawn.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites that the curved form has portions in the heel portion and forefoot region of the sole portion. However, claim 1 recites in line 12 "the forefoot region has a curved form." This indicates that the curved form is present only in the forefoot region. It is unclear how the curved form extends from the heel portion to the forefoot region, when it is previously recited as only a part of the forefoot region.

#### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 3728

4. Claims 1, 3, 6-9, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgeas (US 3,990,159) in view of Girard (US 2002/0007570) and Rudy (US 4,506,460).

Borgeas discloses a shoe having a sole portion which increases in thickness from the heel portion to the forefoot region. The angle of declination may be 5 degrees (column 5, lines 47-52; Fig. 8, 10). The forefoot region has a curved form. A sidewall portion (ridge 16) extends upwardly to form a circumferential edge. The edge rises higher above the heel portion than the forefoot region (Fig. 8, 10).

Borgeas does not disclose a constraining device that constrains the metatarsal-phalangeal joints. Girard teaches providing a constraining device (tightening mechanism 64) over the metatarsal-phalangeal joint of the foot. The constraining device helps to constrain the foot while still allowing bending of the footwear (paragraphs 0011, 0012, 0069; Fig. 9). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided a constraining device, as taught by Girard, to the shoe of Borgeas in order to better hold the foot in place while exercising while still allowing bending of the footwear.

Borgeas and Girard do not disclose that the forefoot region is made of a high density material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the forefoot region of a high density material in order to provide a springing action to the foot. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its

Art Unit: 3728

suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

The combination of Borgeas and Girard does not disclose a hard, high density insert in the forefoot region. Rudy teaches providing a hard, high-density insert (moderator 16) in the forefoot region of a shoe sole. The insert may have reinforcing ribs (Fig. 8). The insert may have slits (cut-out sections 23, 24) to define the bending moment of inertia. The insert acts to improve the energy absorption, redistribution, storage and energy return of the sole (column 2, lines 38-45; column 10, lines 20-53; column 11, lines 25-31; Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided an insert, as taught by Rudy, in order to improve the springing action and energy redistribution of the shoe.

Rudy teaches that the insert is made of a hard, high density material (such as steel, column 10, lines 20-36), but does not disclose the specific hardness of the material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the insert with a shore hardness of between 20 and 90, since the claimed values are merely an optimum or workable range. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Art Unit: 3728

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borgeas, Girard, and Rudy, as applied to claims 1, 3, 6-9, 12, and 15, further in view of Carlson et al. (US 6,362,387), herein Carlson.

The combination of Borgeas, Girard, and Rudy does not disclose a reinforced, padded toe portion. Carlson teaches providing padding (patches 86, 88, 100) in the toe portion of the shoe in order to decrease friction and increase comfort for the wearer (column 7, lines 58-67; column 8, lines 1-43; Fig. 10). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided padding in the toe portion, as taught by Carlson, in order to improve comfort for the wearer.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borgeas, Girard, and Rudy, as applied to claims 1, 3, 6-9, 12, and 15, further in view of Jackinsky (US 6,785,984).

The combination of Borgeas, Girard, and Rudy does not disclose that the heel portion is made of a low density, viscous-like material. Jackinsky teaches a shoe having a sole (16) in which the forefoot region has a greater thickness than the heel portion, creating an angle of declination ( $\gamma$ ). The forefoot region is made of a higher density material (particularly sections 20e, 20g), while the heel portion is made of a lower density material (column 4, lines 45-51; column 5, lines 45-47). The differing densities allow for cushioning as well as springing qualities in the sole. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided a lower density material in the heel section, as taught by Jackinsky, in order to

Art Unit: 3728

allow for greater cushioning in the heel portion while still maintaining the spring-like properties in the forefoot region.

***Allowable Subject Matter***

7. Claims 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1, 3, and 6-16 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHARON M. PRANGE whose telephone number is (571)270-5280. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. M. P./ 10/9/10  
Examiner, Art Unit 3728

/Mickey Yu/  
Supervisory Patent Examiner, Art  
Unit 3728